

Application No. 08/819,669

Docket No.: NY-LUD 5253-US5-DIV

Response dated December 12, 2006

Reply to Office Action of December 4, 2006

This is absurd. The absurdity is exemplified, e.g., by the fact that the current Office Action bases rejections on a reference, i.e., U.S. Patent No. 5,843,448, which the Examiner admits has been of record for 5½ years.

Applicants note the Examiner's apology, and it is not sufficient. The delays in prosecuting this case have been discussed with former Group Director Chambers previously. Applicants were promised speedy resolution. This did not happen.

There is no excuse for this type of delayed prosecution. The Examiner, the Supervisory Primary Examiner, and the Group Direct, all of whom signed the last Office Action, have been copied on this response.

If action is not taken within 2 weeks, applicants will have no choice but to take this matter to the Commissioner's office directly, to get resolution.

Regarding the issues, it is believed there are only two. The first is an alleged double patenting rejection over U.S. Patent No. 5,843,448 - a rejection which ought to have been made in 2001.

A Terminal Disclaimer is attached. This resolved that issue.

Regarding the rejection under 35 U.S.C. § 102(f), the Examiner misreads the claims, misinterprets the law, and has not reviewed the cases carefully.

First, it is believed that the Examiner is estopped from making the rejection under 35 U.S.C. § 102(f).

If the invention claimed here is the same as the invention of the '448 case, then the '448 case should not have issued.

In fact, '448 did with the current case having been cited during its prosecution.

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A review of the front page of 5,843,448, indicates that WO 92/20356 was cited during its prosecution so, too, was 5,342,774 to Boon et al.<sup>1</sup> The '774 patent is the priority case to the present case. The present case is the national filing of the WO 92/20356 case. The USPTO has already taken a position contrary to that taken by the Examiner here. Consistency dictates that the same conclusion, which is a legal conclusion, be reached here.

Further, for a 102(f) rejection to be proper, the invention must be the same. It is not. The Examiner concedes this, by making an obviousness type double patenting rejection, rather than one under 35 U.S.C. § 101. Indeed, the claims of this application stand as generic to the species of 5,843,448. Such a situation is common. The fact that the inventors differ in cases which stand in genus/species relationship, is also not unheard of. For this to constitute a valid grounds for a rejection under 35 U.S.C. § 102(f) is clearly improper, and should be withdrawn.

Yet further, the Examiner makes much of the fact that there is no inventor in common between the two cases, i.e., 5,843,448 and the current application. This, however, is not true. The '448 patent issued with incorrect inventorship on its face, due to USPTO error.

U.S. Patent No. 5,843,448, was filed as a divisional of U.S. Patent No. 5,541,104. The inventorship on the '104 patent was: Yao-Tseng Chen; Elisabeth Stockert; Yachi Chen; Pilar Garin-Chesa; Wolfgang Rettig; Pierre van der Bruggen; Thierry Boon-Falleur; and Lloyd J. Old.

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<sup>1</sup> The '448 patent provides an incorrect number for the Boon patent; however, applicants have brought this to the USPTO's intentions in the present case, following one of the suspensions.

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Pierre van der Bruggen and Thierry Boon-Falleur are co-inventors on the subject application. They do not appear on '448 due to USPTO error. Three attempts were made to correct this.

Attached is a copy of a first request for a corrected filing receipt, dated August 7, 1996, a second request for a correct filing receipt, dated October 19, 1998, and a rush telefax, sent to Tawana Mills (sic; Tajuanna) of the publication divisional on November 23, 1998, sending a copy of the signed declaration for -co-inventors Pierre van der Bruggen and Thierry Boon-Falleur.

IMMEDIATE action on this case is called for.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0624, under Order No. NY-LUD 5253-US5-DIV (09885911) which the undersigned is authorized to draw.

Dated: December 12, 2006

Respectfully submitted,

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